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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,550	03/13/2001	Pramod B. Mahajan	0964D	2785

27310 7590 07/30/2003

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EXAMINER

HELMER, GEORGIA L

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 07/30/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,550

Applicant(s)

MAHAJAN ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 68-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 68-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Status of the Claims

1. The Office acknowledges receipt of Applicants Response; dated 9 April 2003, paper number 11. The Examiner further acknowledges the use of the "revised Amendment Format" with appreciation.
2. Claims 1-4 and 7 are amended. Claims 75-84 have been added.
3. New claims 75-84 have been renumbered to comply with MPEP 1.126, since the highest numbered claim previously was claim 67. Accordingly, claims 75-84 have been renumbered to claims 68-77. The renumbered claims are referenced in this action.
4. Claim 74 (previous claim 81) is recited as depending on itself. This is an incorrect claim dependency. In order to expedite prosecution, the Examiner presumes that this claim is dependent on claim 71. However, this does not relieve Applicant of the obligation to correct the claim dependency.
5. Claims 1-7 and 68-77 are pending, and are examined in the instant action.
6. This action is made FINAL necessitated by Applicant's amendment.
7. All rejections not addressed below have been withdrawn.
8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

9. The Office acknowledges receipt of Applicant's IDS, Paper No. 9, filed 8 April 2003. A signed and dated copy of the 1449 form is included.

Double Patenting

10. Claims 2-7 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,232,527. Although the conflicting claims are not identical, they are not patentably distinct from each other. The recombinant expression cassette of claim 2, comprising DNA encoding the polypeptide of SEQ ID NO: 2 or SEQ ID NO: 4, is obvious over the claims of 6,235,972, which are drawn to the same DNA. It would have been obvious to use the DNA in an expression cassette to transform host cells and plants.

Applicant traverses, stating primarily that claim 2 is directed to a recombinant expression cassette which expresses the polypeptide of claim 1. In addition, claims 3-7 now depend from claim 1 and therefore are removed from the double parenting rejection. Therefore the claim is defined by the polypeptide which was restricted out of US 09/413,574 as a separate invention.

Applicant's traversal has been considered and is unpersuasive because claims 2-7 are drawn to the same DNA, of the same host cell and plant as 09/413,574. Accordingly this rejection is maintained.

Claim Rejections - 35 USC § 112-first

Written Description

11. Claims 1-7 and 68-70 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

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to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant traverses, stating primarily that evidence submitted in Appendices A and B confirms the identity of the claimed Rad23 sequences.

Applicant's traversal has been considered and is unpersuasive because while Applicant's evidence submitted in Appendices A and B includes alignment with other sequences, how this evidence relates to the claimed percentages sequence identity of the SEQ ID NO: 2 and SEQ ID NO: 4 is not clear.

Claim Rejections - 35 USC § 101

12. Claims 3, 72, and 73 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims read on a maize cell that would naturally comprise said polypeptide.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-7 and 72-77 are rejected under 35 U.S.C. 102(b) as being anticipated by Lundquist, et. al., US 5,554,798, issued 10 September 1996.

Lundquist teaches a nonhuman host cell, a transgenic maize plant (claim 8), and a monocot, comprising a polypeptide having 80, 85, 90, and 95 % identity with SEQ ID

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NO: 2. Lundquist also teaches a host cell, a transgenic maize plant and seed (Table 4, col 21, and claims 1, 2, 3, and 5) comprising SEQ ID NO: 2 and 4.

Accordingly, Lundquist anticipates the claimed invention.

REMARKS

14. No claims are allowed.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

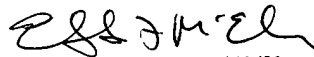
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer
Patent Examiner
Art Unit 1638
July 25, 2003


ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800